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09/476,319 12/30/99 HASEBE

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EXAMINER

BARRON JR, G

ART UNIT

PAPER NUMBER

2132

13

DATE MAILED: 10/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

[Handwritten signature]

Office Action Summary

Application No.

09/476,319

Applicant(s)

HASEBE ET AL.

Examiner

Gilberto Barrón Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001 and 02 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/031,339.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. The Amendment (including Supplemental Amendment filed 10/2/01) received on July 19, 2001 has been carefully considered, but is not persuasive in overcoming the rejection(s) presented in the previous Office Action of January 19, 2001. Applicant's response has also necessitated new grounds of rejection. The grounds of rejection are presented below followed by a response to Applicant's arguments. The newly submitted claims 19-125 are listed in the grounds of rejection as appropriate.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

RECAPTURE OF SUBJECT MATTER

3. Claims 1-10 and 17-125 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

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U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The prosecution record of the parent application 08/603,760, includes a response (paper no. 7, received November 13, 1996) from Applicant that amended independent claim 13 (now claim 1) to include the limitation "and said medium personal number is used for generating an decryption key for decrypting said encrypting electronic data in said user computer". The response also amended claim 18 (now claim 6) to include the limitation "and said medium personal number is used for generating an encrypted permission information in said vendor computer". Further, claims 13, 18, and 23 (now claims 1, 6, and 11, respectively) were all amended to include the limitation "accessed by a vendor computer and a user computer, said storage medium (for storing) information readable by said user computer". The response presents arguments that clearly indicate that the limitations were specifically included to differentiate from the prior art cited in the grounds for rejection, and therefore place the claims in condition for allowance.

The present amendment seeks to remove the limitations, added in order to gain allowance, and therefore attempts recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claims 1, 6 and 17-125 do not include the limitations regarding the generation of the decryption key or the encrypted permission information.

Claims 17-125 further do not include the limitation that provides a basis for imparting functionality from the storage medium to a computer that may execute the

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program stored on the storage medium. This limitation was included in order to overcome the rejection of claims directed to non-statutory subject matter in the parent application.

Claim Rejections - 35 USC § 112

4. Claim 1-125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "that is not dependent on a specific device identifier for a specific device" is ambiguous since the storage medium is a specific device having a specific identifier, i.e., the medium personal number.

5. Claims 19-125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly submitted claims 19-125 have been submitted with the remark that they have been added to more completely claim Applicant's invention. However, the claims are indefinite because it is not clear how they differentiate from each other, or how they more completely claim Applicant's invention.

The instant application is a reissue designed to correct an error in the original patent. It is not clear what "error" is being corrected and how the addition of claims 19-125 corrects this error. Further, it is not clear how each of the newly submitted claims differ from one another and where support for the differences are found in the specification, i.e., the specification may be used as a guide in interpreting claims.

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Applicant is required to point out how the newly submitted claims differ from one another in scope and subject matter and where support for each of these differences are found in the original disclosure in order to provide the examiner with a guide in how to interpret and determine if the newly submitted claims pass muster with respect to 112, 2nd paragraph requirements.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-125 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "that is not dependent on a specific device identifier for a specific device" is not described in the written description of the instant application. The specification discloses a capability that allows the storage medium to be used by an authorized user in a different computer, see column 3, lines 58-64 and column 5, lines 5-9. However, this description does not provide support for the limitation "is not dependent on a specific device identifier for a specific device". There is no written description of a specific identifier and consequently, the absence of the use of a specific identifier.

8. Claims 1-125 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-125 include the limitation “that is not dependent on a specific device identifier for a specific device”. This limitation is not described in the written description of the invention so as to allow one skilled in the art to make and practice the invention. In particular, the specification indicates that the permission information is based on the medium personal number. However, the specification lacks enablement as to how this is to be practiced. The disclosure solely indicates that the medium personal number is used within a personal key generating circuit, see Fig. 2, # 21 and 31, to generate a key that encrypts/decrypts the software decryption key. The result is the encrypted/decrypted permission information. The lack of enablement is that the manner of accomplishing the result is not disclosed. Column 8, lines 13-15 and column 9, lines 34-38, indicate that a “known safety means” protects a secret key or a secret algorithm needed to generate the personal key. However, this feature is never described or taught as to how the secret key or secret algorithm is transferred to the user or user computer, or how this is to be accomplished.

Claim Rejections - 35 USC § 101

9. Claims 1-10, 17-94, and 124-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are non-statutory because they seek to claim a storage medium with descriptive subject matter that is non-functional, and also lacks the necessary structure to impart functionality or cause a computer to execute a statutory

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process. The subject matter is now presented in a manner that merely catalogs the different information stored on a storage medium. The information is not presented so as to recite the functionality that would be imparted to a computer, but rather is merely a listing of the information on the storage medium.

The newly presented claims 19-94 and 124-125, also do not recite structure or limitations that would enable the storage medium to interact with a computer or impart to a computer a statutory process for execution. The parent application overcame a non-statutory rejection by amending the preamble to provide access by a vendor computer and a user computer and to recite in the body of the claim a functionality that was imparted to one or both, i.e., a decryption key was generated or an encrypted permission information was generated.

Claim Rejections - 35 USC § 102

10. Claims 1-2, 6-7, 11-12, 17-20, 29-30, 39-40, 49-50, 57-58, 67-68, 77-78, 87-88, and 91-125 are rejected under 35 U.S.C. 102(b) as being anticipated by MATYAS (4,757,534 hereinafter as '534).

The '534 patent discloses a software protection system that includes a storage medium (a diskette) accessed by a storage readable apparatus (a user computer). The protection system provides for a medium personal number unique to each storage medium written onto the storage medium in an un-rewritable form which a user storage readable apparatus cannot rewrite. See Figure 2 and 7 of '534 where the diskette serial number, and also col. 5, lines 30-37 is disclosed as recorded in the header record of the

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diskette, which is an un-rewritable form. The diskette serial number is used in the generation of the decryption key for decrypting the encrypted electronic data or generating encrypted permission information or for decrypting the encrypted electronic information which is encrypted based on the medium personal number.

Response to Arguments

11. Applicant's argument that MATYAS teaches a specific device identifier while the present invention does not, is not persuasive. The instant invention also requires a secret key or algorithm to be agreed upon by the vendor computer and the user computer in order to generate the personal key, i.e., encryption of the medium personal number. MATYAS discloses that the secret key may be assigned to a user, and not a specific computer, by way of a password, see column 6, lines 59-66, to meet a limitation that attempts to "decouple" a specific computer identifier from the generation of the encrypted permission information or the encryption of a software key.

12. Applicant's argument that the instant invention does not generate a password from the diskette serial number, user computer number and program number as disclosed in Matyas is not persuasive. The examiner is not suggesting that the password is comparable to the recited medium personal number. Rather, that Matyas discloses using a diskette serial number, among other information, to generate the encryption/decryption key. The claims, given their broadest reasonable interpretation consistent with specification, encompass subject matter where the electronic information is encrypted based upon the medium personal number or where the

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medium personal number is used to generate a decryption key for decrypting the encrypted electronic data. Matyas discloses these two features. The diskette serial number, as disclosed in Matyas, is used to generate the key and/or the encrypted data is encrypted based on the diskette serial number. That other information, such as program number and computer number, as disclosed in Matyas, are included in the generation of the decryption key or that the encryption is based on such other included information, does not preclude anticipation of the broad recitation of the encryption based on the medium personal number or of generating a decryption key based on the medium personal number, as Matyas discloses that the diskette serial number is used in the formation of the decryption key and/or the encryption of the encrypted information is based on the diskette serial number.

Claim Rejections - 35 USC § 103

13. Claims 3-5, 8-10, 13-16, 21-22, 31-32, 41-42, 51-52, 59-60, 69-70, 79-80 and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (4,757,534) in view of Shear (4,827,508 hereinafter '508).

The '534 patent discloses a diskette as the storage medium while the instant claims provide for optical disks and/or cd-ROMS. The Shear '508 patent teaches a security system for metering the usage and billing for the use of a digital database. The digital database is provided on an optical disk or a cd-rom, see col. 2, lines 29-57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an optical disk or cd-rom as taught in Shear '508 for the diskette of Matyas '534 in order to store large amounts of information for distribution to various users.

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Shear also teaches using different coding for different files stored on the medium, see col. 15, lines 51-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plural encrypted data each having different coding as taught in Shear '508 in the storage medium of Matyas '534 in order to protect the electronic data according to different uses and/or payment types.

Information Disclosure Statement

14. The documents submitted July 3, 2001 has been considered. An initialed PTO-1449 is attached to this action. No new grounds of rejection based on these documents, or those submitted on April 18, 2000 is deemed necessary at this time. However, this does not preclude further action based on these documents. In particular, JP-A-3-30020, submitted April 8, 2000 discloses permission information for an authorized user and not a computer.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

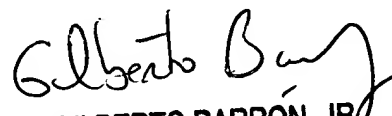
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. Albert Decady, can be reached on (703) 305-9595, or Ms. Gail Hayes, can be reached on (703) 305-9711.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


GILBERTO BARRÓN, JR.
PRIMARY EXAMINER
ART UNIT 222/2132